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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,075	07/06/2001	Satoshi Hoshino	Q65358	3548

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER	
BORLINGHAUS, JASON M	
ART UNIT	PAPER NUMBER
3693	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/899,075	<b>Applicant(s)</b> HOSHINO, SATOSHI	
	<b>Examiner</b> Jason M. Borlinghaus	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/6/01, 11/22/02 and 1/16/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/6/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some   \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/6/01; 11/22/02; 1/16/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 8 and 12 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art (see pp. 1 – 2).

**Regarding Claims 1, 3, 5 and 7**, Disclosed Prior Art discloses an authenticity checker of driver's license comprising:

- a driver's license shooting section capable of shooting a watermark of a driver's license from the obverse side. (see p. 1, lines 15 - 18);
- an authenticity judging section which judges the driver's license is forgery when neither of the watermarks shot from the obverse side by the driver's license shooting section is recognized as a regular watermark, and judges the driver's license is authentic when the watermarks is recognized as a regular watermark. (see p. 1, lines 15 – 18);
- wherein the driver's license shooting section includes a first camera to shoot the driver's license from the obverse side. (see p. 1, lines 15 – 18);
- a first light to irradiate the driver's license from the reverse side (backside). (see p. 1, lines 15 – 18);
- a camera for shooting a driver's license. (see p. 1, lines 15 – 18);

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- a light which is placed opposite to a lens of a camera. (see p. 1, lines 15 – 18);
- a revolving means for revolving the driver's license between the lens and the light so that the obverse or the backside of the driver's license is placed opposite to the lens. (see p. 1, lines 15 – 18);
- wherein the driver's shooting section includes a camera. (see p. 1, lines 15 – 18);
- first light for irradiating one side (backside) of the driver's license which has been carried to a fixed placed. (see p. 1, lines 15 - 18); and
- first optical system for propagating light, which has been outputted from the first light and transmitted through the driver's license (backside), to the camera. (see p. 1, lines 15 - 18).

Disclosed Prior Art does not teach underlined claim limitations – an authenticity checker of driver's license comprising:

- a driver's license shooting section capable of shooting a watermark of a driver's license from both obverse and reverse side;
- an authenticity judging section which judges the driver's license is forgery when neither of the watermarks shot from the obverse nor reverse side by the driver's license shooting section is recognized as a regular watermark, and judges the driver's license is authentic when at least one of watermarks is recognized as a regular watermark;

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- wherein the driver's license shooting section includes first and second cameras to shoot the driver's license from the obverse and reverse side;
- first and second lights to irradiate the driver's license from the reverse and obverse side;
- a conveyor means for carrying a driver's license;
- first and second lights for irradiating one side and the other side of the driver's license which has been carried to a fixed placed by the conveyor means; and
- first and second optical systems for propagating light, which has been outputted from the first or second light and transmitted through the driver's license, to the camera.

Examining a document and/or identification from both sides, either via a manual or an automated system, is old and well known in the art of authentication and verification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art with the ability to examine both sides of the driver's license, allowing for examination of the watermarks, images and/or identifying information that could be located on either side of the license, rather than just examination of the one side, as such identifiers could be located on the opposing side of the license that was originally present or on both sides of the license.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art to provide an additional light and an additional camera to examine the driver's license from an additional angle,

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since it has been held that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art to allow for any device and/or method by which to place the examined driver's license in between the light and the camera, as disclosed by Disclosed Prior Art, that the inventor desired such as via a conveyor belt, robotic claw or a tube slot. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

**Regarding Claims 2, 4, 6 and 8**, Claims 2, 4, 6 and 8 recite similar limitations and/or would have been obvious based upon Claims 1, 3, 5 and 7 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1, 3, 5 and 7.

**Regarding Claims 12 - 13**, Claims 12 – 13 recite similar limitations and/or would have been obvious based upon Claims 1 – 8 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 8.

**Claims 9 – 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art, as applied to Claims 1 - 8 above, and further in view of Soltesz (WO 99/30267).

**Regarding Claims 9 – 11**, Disclosed Prior Art discloses a machine comprising:

- an image camera for shooting a watermark. (see p. 1, lines 15 – 18);

Disclosed Prior Art does not teach underlined claim limitations – an automated – teller machine comprising:

- an image camera for shooting a facial portrait of a user; and
- a face image collator for verifying identity of the user by collating an image of a photograph attached to his/her ID card with image data of the facial portrait shot by the image camera;
- a transmitting section for transmitting image data of the facial portrait obtained by the image camera to a server; and
- a server for identifying the user based on pre-registered face image data of plural users and the image data transmitted from the transmitting section.

Soltesz discloses an automated teller machine (self-service kiosk/ATM) comprising (see p. 1, lines 3 - 12):

- an image camera for shooting a facial portrait of a user (biometrics capture device); (see abstract)
- a face image collator (controller) for verifying (comparing) identity (biometrics data) of the user by collating an image of a photograph (biometrics data) attached to his/her ID card (optical card) with image data of the facial portrait (biometrics data) shot by the image camera (biometrics capture device). (see abstract);
- a transmitting section (controller) for (optionally) transmitting image data (biometric data) of the facial portrait obtained by the image camera

(biometric input device) to a server (central data base). (see p. 16, lines 57 – 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art by incorporating the authenticity checker into an ATM, as disclosed by Soltesz, allowing for the use of identification verification in a money dispensing transaction, a standard and/or conventional procedure in such a transaction.

Furthermore, as biometric data, such as a facial image, is a standard and/or conventional identifier located on an identification card, such as a driver's license, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Soltesz by incorporating the capability to authenticate through biometrics data, such as facial imaging, as disclosed by Soltesz, in addition to a watermark, as the use of such information for identification purposes is standard and/or conventional.

While Soltesz does not transmit data obtained to a remote server for identification purposes, such computer system architecture is old and well known, for as Soltesz states "...communications with a remote database are not required in order to perform the verification and/or authentication." (see p. 15, lines 11 – 13). While Soltesz opts not to utilize such an architecture it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Soltesz to allow for any computer system architecture that the inventor desired such as performance of identification processes on site or via transmission for




processing at a remote location. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
ELI A. COLBERT  
PRIMARY EXAMINER

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